



DEPARTMENT OF COMMERCE

[3510-16]

United States Patent and Trademark Office

37 CFR Parts 2 and 7

[Docket No. PTO-T-2013-0027]

RIN 0651-AC89

Changes in Requirements for Collective Trademarks and Service Marks, Collective Membership Marks, and Certification Marks

AGENCY: United States Patent and Trademark Office, Commerce

ACTIONS: Notice of Proposed Rulemaking

SUMMARY: The United States Patent and Trademark Office (“USPTO”) proposes to amend the rules related to collective trademarks, collective service marks, and collective membership marks (together “collective marks”), and certification marks to clarify application requirements, allegations of use requirements, multiple-class application requirements, and registration maintenance requirements for such marks. These proposed rule changes will codify current USPTO practice set forth in the USPTO’s “Trademark Manual of Examining Procedure” (“TMEP”) and precedential case law. These changes also will permit the USPTO to provide the public more detailed guidance regarding registering and maintaining registrations for these types of marks and will promote the efficient and consistent processing of such marks. Further, the USPTO proposes to amend several rules beyond those related to collective marks and certification marks to create consistency with rule changes regarding such marks and to streamline the rules, by consolidating text and incorporating headings, for easier use.

DATES: Written comments must be received on or before [INSERT DATE 90 DAYS AFTER DATE OF PUBLICATION IN THE FEDERAL REGISTER] to ensure consideration.

ADDRESSES: The USPTO prefers that comments be submitted via electronic mail message to TMFRNotices@uspto.gov. Written comments also may be submitted by mail to Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451, attention Cynthia Lynch; by hand delivery to the Trademark Assistance Center, Concourse Level, James Madison Building-East Wing, 600 Dulany Street, Alexandria, Virginia, attention Cynthia Lynch; or by electronic mail message via the Federal eRulemaking Portal. See the Federal eRulemaking Portal Web site (<http://www.regulations.gov>) for additional instructions on providing comments via the Federal eRulemaking Portal. All comments submitted directly to the USPTO or provided on the Federal eRulemaking Portal should include the docket number (PTO-T-2013-0027). Written comments will be available for public inspection on the USPTO's Web site at <http://www.uspto.gov> as well as at the Federal eRulemaking Portal, and at the Office of the Commissioner for Trademarks, Madison East, Tenth Floor, 600 Dulany Street, Alexandria, Virginia. Because comments will be made available for public inspection, information that is not desired to be made public, such as an address or phone number, should not be included.

FOR FURTHER INFORMATION CONTACT: Cynthia Lynch, Office of the Deputy Commissioner for Trademark Examination Policy, at (571) 272-8742 or tmpolicy@uspto.gov.

SUPPLEMENTARY INFORMATION

Executive Summary: Purpose: The proposed rules will benefit the public by providing more comprehensive and specific guidance regarding registering collective marks and certification marks. The current rules incorporate by reference the trademark and service mark

application rules; however, wording in the trademark and service mark application rules sometimes may not be specifically suited to collective and certification mark applications. Therefore, the USPTO proposes to revise the rules in parts 2 and 7 of title 37 of the Code of Federal Regulations to codify current USPTO practice in TMEP sections 1302, 1303 et seq., 1304, and 1306, and to state clearly and provide sufficient detail regarding the requirements for collective and certification mark applications. The USPTO also seeks to harmonize registration maintenance requirements with application requirements where appropriate.

Further, proposed rule changes beyond those related to collective marks and certification marks will provide consistency with changes made regarding those marks and streamline the rules, by consolidating text and incorporating headings, for easier use.

To provide additional context for the ensuing discussion of the amended and revised rules regarding collective marks and certification marks, the following is a brief description of those types of marks.

There are two types of collective marks as defined by section 45 of the Trademark Act of 1946, as amended (“the Act”): (1) collective trademarks or collective service marks; and (2) collective membership marks. 15 U.S.C. 1127. A collective trademark or collective service mark is used by members of a collective organization to identify and distinguish their goods or services from those of nonmembers. TMEP section 1303. By contrast, collective membership marks are used by members of a collective organization to indicate membership in the collective membership organization. TMEP section 1304.02.

Certification marks are used by authorized users to indicate the following: (1) goods or services have been certified as to quality, materials, or mode of manufacture; (2) goods or

services have been certified to originate in a specific geographic region; and/or (3) the work or labor on goods or for services was certified to have been performed by a member of a union or other organization, or to certify that the performer meets certain standards. TMEP section 1306.01. A certification mark is similar to a collective trademark or collective service mark except that the users are not members of a collective organization. See TMEP section 1306.09(a). That is, a collective trademark or collective service mark is used by members of an organization who meet the collective organization's standards of admission, while a certification mark is used by parties whose products or services meet the certifying organization's established standards.

Summary of Major Provisions: As stated above, the USPTO proposes to revise the rules in parts 2 and 7 of title 37 of the Code of Federal Regulations to codify current USPTO practice in TMEP sections 1302, 1303 et seq., 1304, and 1306, and to state clearly, and provide sufficient detail regarding, the requirements for collective and certification mark applications, as well as to harmonize registration maintenance requirements with application requirements where appropriate. Further, the USPTO proposes to revise additional rules within these parts for consistency and clarity.

Costs and Benefits: This rulemaking is not economically significant under Executive Order 12866 (Sept. 30, 1993).

Discussion of Specific Rules

The USPTO proposes to amend the following rules: §§ 2.2, 2.20, 2.32-.34, 2.41-2.42, 2.44-2.45, 2.56, 2.59, 2.71, 2.74, 2.76, 2.86, 2.88-2.89, 2.146, 2.161, 2.167, 2.173, 2.175, 2.183, 2.193, 7.1, and 7.37.

PART 2: RULES OF PRACTICE IN TRADEMARK CASES

Rules Applicable to Trademark Cases

The USPTO proposes to amend and add terms to § 2.2, regarding definitions, to delete repetitious wording elsewhere in the rules wherever possible. Specifically, the USPTO proposes to amend § 2.2(h) to clarify that the definition of “international application” is limited to an application for international registration seeking an extension of protection to the United States or a subsequent designation of an international registration to the United States. The USPTO also proposes to add § 2.2(i) through (n) to set forth the following new definitions: subsequent designation; holder; use in commerce; bona fide intention to use the mark in commerce; bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce; and verified statement, verify, verified, or verification.

Declarations

The USPTO proposes to amend § 2.20, regarding declarations in lieu of oaths, to delete from the introductory text the term “verification,” to correspond with the definition of that term in § 2.2(n), and to add the term “declaration.”

Application for Registration

The USPTO proposes to amend the rule title of § 2.32 to “Requirements for a complete trademark or service mark application.” In addition, the USPTO proposes to add § 2.32(f) to cross-reference § 2.44 for the requirements for collective mark applications, and to add § 2.32(g) to cross-reference § 2.45 for the requirements for certification mark applications.

The USPTO proposes to amend § 2.33, regarding verified statements for trademarks or service marks, to ensure the language corresponds with other proposed rules, including the proposed new definitions in § 2.2. Also, the USPTO proposes to add § 2.33(f) to set forth the type of verified statement required for concurrent use applications under § 2.42. Additionally, the USPTO proposes to amend the title of § 2.33 to “Verified statement for a trademark or service mark.”

The USPTO proposes to amend § 2.34, regarding filing bases for trademark or service mark applications, to ensure the language corresponds with other proposed rules, including the proposed new definitions in § 2.2, to delete the definition of “commerce” provided in § 2.34(c) as redundant of section 45 of the Act, and to correct a typographical error. The USPTO further proposes to amend the title to “Bases for filing a trademark or service mark application.” Additionally, the USPTO proposes to amend § 2.34(a)(1)(iv) to delete “actually” as a redundant term for consistency with proposed amendments to § 2.56(b)(2) and (c) regarding specimens, § 2.76(b)(2) regarding amendments to allege use, § 2.88(b)(2) regarding statements of use, and § 2.161(g)(1) regarding affidavits or declarations of use in commerce or excusable nonuse under section 8 of the Act. Lastly, the USPTO proposes to revise current § 2.34(b)(1)-(3) by condensing the text in § 2.34(b), and add the title “More than one basis.”

The USPTO proposes to revise § 2.41, regarding proof of distinctiveness under section 2(f) of the Act, to specify the type of proof required to establish such a claim for trademarks, service marks, collective marks, and certification marks, and to make other changes consistent with current USPTO practice. Specifically, the USPTO proposes to revise § 2.41 as follows: in § 2.41(a), add the title “For a trademark or service mark” and set forth in § 2.41(a)(1)-(3) the current text in existing § 2.41; in § 2.41(b), add the title “For a collective trademark or collective service mark” and set forth in § 2.41(b)(1)-(3) the requirements for collective trademarks or collective service marks. The USPTO also proposes to add the following to § 2.41: in § 2.41(c), set forth the requirements for collective membership marks; and in § 2.41(d), set forth the requirements for certification marks. Further, the USPTO proposes additional revisions to correspond with the proposed new definitions in § 2.2 and include subsections with subheadings that set forth the three types of proof that can be submitted to establish distinctiveness under 15 U.S.C. 1052(f). In addition, proposed § 2.41(a)(1), (c)(1), and (d)(1) add the term “active” to clarify and codify current USPTO practice, see TMEP section 1212.04(d), that evidence of distinctiveness must be based on ownership of an active prior registration on the Principal Register or under the Trademark Act of 1905. Further, proposed § 2.41(a)(1) and (d)(1) clarify that such registration must be for goods or services sufficiently similar to those in the application, and proposed § 2.41(c)(1) adds that the nature of the collective membership organization must be sufficiently similar to the prior registration, and such requirement in proposed § 2.41(a)(1), (d)(1), and (c)(1) codifies precedential case law and current USPTO practice, see In re Dial-A-Mattress Operating Corp., 240 F.3d 1341, 1347, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001), In re Rogers, 53 USPQ2d 1741, 1744 (TTAB 1999), TMEP sections 1212.04(c), 1212.09(a). Lastly, proposed § 2.41(e) excludes from § 2.41(d) geographic matter in

certification marks that indicate regional origin, because 15 U.S.C. 1052(e)(2) explicitly excepts such terms in certification marks including indications of regional origin. See TMEP section 1306.02.

The USPTO proposes to revise § 2.42, regarding concurrent use requirements, to incorporate requirements for collective marks and certification marks, as well as to make other changes consistent with current USPTO practice. Specifically, the USPTO proposes to revise § 2.42 as follows: add § 2.42(a), to require an application for registration as a lawful concurrent user to assert use in commerce in accordance with current USPTO practice, see TMEP section 1207.04(b), and the USPTO's "Trademark Trial and Appeal Board Manual of Procedure" section 1101.01, to require an application for concurrent use be for a mark seeking registration on the Principal Register under the Act, in accordance with current § 2.99(g), and to include all relevant application requirements, including § 2.44 for collective marks or § 2.45 for certification marks, if applicable. In addition, the USPTO proposes to add § 2.42(b) to enumerate the additional requirements for concurrent use applications set forth in the existing second sentence of current § 2.42 and to modify such text to incorporate the requirements for collective marks and certification marks. Further, the USPTO proposes to add § 2.42(c) to cross-reference current § 2.73, pertaining to amending an application to recite concurrent use, and to add § 2.42(d) to cross-reference current § 2.99, pertaining to concurrent use proceedings at the Trademark Trial and Appeal Board.

The USPTO proposes to revise § 2.44, regarding collective marks, to include all requirements for a collective mark application in one rule. Specifically, the USPTO proposes to revise § 2.44 as follows: in § 2.44(a), enumerate the application requirements for a collective mark, incorporating the relevant application requirements from current § 2.32, regarding the

requirements for a complete trademark or service mark application, current § 2.44, and current USPTO practice, see TMEP sections 1303.02 et seq. for collective trademarks and collective service marks, and TMEP section 1304.08(c)-(f) for collective membership marks; and in § 2.44(b), specify the requirements for a verified statement that was not filed within a reasonable time after signing or was omitted from the application to correspond with proposed § 2.33(c) and § 2.34(a)(1)(i), (a)(2), (a)(3)(i), and (a)(4)(ii). The USPTO also proposes to add the following to § 2.44: in proposed § 2.44(c), specify the requirements for claiming more than one filing basis in the application to correspond with proposed § 2.34(b); in proposed § 2.44(d), specify the requirements for the verification in a concurrent use application to correspond with proposed § 2.33(f); and in proposed § 2.44(e), cross-reference the multiple-class application requirements rule in proposed § 2.86 for consistency with proposed § 2.32(e). Further, the USPTO proposes additional revisions to correspond with the proposed new definitions in § 2.2. Also, the USPTO proposes to amend the title to “Requirements for a complete collective mark application” for consistency with the title in proposed § 2.32 regarding trademark and service mark application requirements.

The USPTO proposes to revise § 2.45, regarding certification marks, to include all requirements for a certification mark application in one rule, and to be consistent with the formatting of proposed § 2.44 for collective mark application requirements. Specifically, the USPTO proposes to revise § 2.45 as follows: in § 2.45(a), enumerate the application requirements for a certification mark, incorporating the relevant application requirements from current § 2.32, regarding the requirements for a complete trademark or service mark application, current § 2.45, and current USPTO practice, see TMEP sections 1306.06 et seq.; and in § 2.45(b), specify the requirements for a verified statement that was not filed within a reasonable

time after signing or was omitted from the application to correspond with proposed § 2.33(c) and § 2.34(a)(1)(i), (a)(2), (a)(3)(i), and (a)(4)(ii) and proposed § 2.44(b). The USPTO also proposes to add the following to § 2.45: in proposed § 2.45(c), specify the requirements for claiming more than one filing basis in the application to correspond with proposed § 2.34(b) and proposed § 2.44(c); in proposed § 2.45(d), specify the requirements for the verification in a concurrent use application to correspond with proposed § 2.33(f) and proposed § 2.44(d); in proposed § 2.45(e), cross-reference the multiple-class application requirements rule in proposed § 2.86 for consistency with proposed § 2.32(e) and proposed § 2.44(e); and in proposed § 2.45(f), prohibit a single application from including both a certification mark and another type of mark, because the USPTO's databases preclude capturing different legal requirements for multiple types of marks in a single application, and also prohibit the registration of the same mark for the same goods and/or services as both a certification mark and another type of mark, in accordance with sections 4 and 14(5)(B) of the Act and current USPTO practice, see TMEP section 1306.05(a). Further, the USPTO proposes additional revisions to correspond with the proposed new definitions in § 2.2. Also, the USPTO proposes to amend the rule title to "Requirements for a complete certification mark application; restriction on certification mark application" for consistency with the title of proposed § 2.32 regarding trademark and service mark application requirements and proposed § 2.44 regarding collective mark application requirements.

Specimens

The USPTO proposes to amend § 2.56(b)(2) and (c), regarding specimens, to delete the term "actually" as a redundant term and for consistency with similar proposed amendments to § 2.34(a)(1)(iv), § 2.76(b)(2), § 2.88(b)(2), and § 2.161(g). Additionally, the USPTO proposes to amend § 2.56(b)(5) to delete "to certify" and replace it with "to reflect certification of."

Lastly, the USPTO proposes to amend § 2.56(d)(3), to delete “audio or video cassette tape recording, CD-ROM” and replace it with “compact disc, digital video disc,” in accordance with current practice, see TMEP section 904.03(d), (f).

The USPTO proposes to amend § 2.59, regarding substitute specimens, to change existing text to “verified statement” to correspond with § 2.2(n). Additionally, the USPTO proposes to amend § 2.59(a) to reference substitute specimens for a collective membership mark.

Amendment of Application

The USPTO proposes to amend § 2.71(a), regarding amendments to the identification of goods and/or services, to reference amending the description of the nature of a collective membership mark. In addition, the USPTO proposes to amend § 2.71(b)-(d) to change existing text to correspond with § 2.2(n). Further, the USPTO proposes to add § 2.71(e) to set forth that an amendment that would materially alter a certification statement pursuant to proposed § 2.45(a)(4)(i)(A) and (a)(4)(ii)(A), is not permitted, which is consistent with proposed § 2.173(f) regarding such amendments after registration.

The USPTO proposes to amend § 2.74(b), regarding the form and signature of an amendment, to change existing text to “verification” to correspond with § 2.2(n).

The USPTO proposes to amend § 2.76, regarding amendments to allege use, to include the relevant requirements for collective marks and certification marks, and to be consistent with proposed § 2.88 for statements of use. Specifically, the USPTO proposes to amend § 2.76 as follows: in § 2.76(a), add the title “When to file an amendment to allege use;” in § 2.76(a)(1) and (a)(2), include the text from existing § 2.76(a) and (c), except delete the language regarding the USPTO returning an untimely filed amendment to allege use because under current practice

the USPTO will not return or review such amendment; in § 2.76(b), add the title “A complete amendment to allege use” and include in § 2.76(b)(1)-(5) the text from existing § 2.76(b) and (c) and the requirements for collective marks and certification marks, in § 2.76(b)(6), require the title “Amendment to Allege Use” on the first page of the document for those documents not filed using the Trademark Electronic Application System (TEAS); in § 2.76(c), add the title “Minimum filing requirements for a timely filed amendment to allege use” and include the text from existing § 2.76(e) and change existing text to “verified statement” to correspond with § 2.2(n); in § 2.76(d), add the title “Deficiency notification” and include the text from existing § 2.76(g); in § 2.76(e), add the title “Notification of refusals and requirements” and include the text from existing § 2.76(f), except the last two sentences regarding the USPTO providing notification of acceptance of an amendment to allege use because current practice is that a notice of approval for publication provides such notice; in § 2.76(f), add the title “Withdrawal” and include the text from existing § 2.76(h); in § 2.76(g), add the title “Verification not filed within reasonable time,” and include the text from existing § 2.76(i) and change existing text to “verified statement” to correspond with § 2.2(n); in § 2.76(h), add the title “An amendment to allege use is not a response but may include amendments” and include the text from the last sentence of existing § 2.76(f) and clarify that an amendment to allege use may include amendments in accordance with § 2.59 and § 2.71 through § 2.75; in § 2.76(i), specify the requirements for the verification in a concurrent use application under § 2.42; and in § 2.76(j), add the title “Multiple-class application.”

Classification

The USPTO proposes to amend § 2.86, regarding multiple-class application requirements, to include the requirements for collective marks and certification marks, and to

make other changes consistent with current USPTO practice. Specifically, the USPTO proposes to amend § 2.86 as follows: in § 2.86(a), set forth the requirements for a single trademark, service mark, and/or collective mark application for multiple classes, clarifying that such an application must satisfy either the trademark or service mark application requirements in § 2.32 or the collective mark application requirements in § 2.44, in addition to providing the applicable goods, services, or nature of the collective membership organization in each appropriate international or U.S. class, and providing a fee, dates of use, and a specimen for each class based on use in commerce or a bona fide intent statement for each class based on section 1(b), 44, or 66(a) of the Act; in § 2.86(b), set forth the requirements for a single certification mark application for goods and services, clarifying that such multiple class application must satisfy the certification mark application requirements in § 2.45, in addition to identifying the applicable goods and services in each appropriate U.S. class for applications filed under section 1 or 44 or in the international classes assigned by the World Intellectual Property Organization's International Bureau for applications filed under section 66(a) of the Act, and providing a fee, dates of use, and a specimen for each class based on use in commerce or a bona fide intent statement for each class based on section 1(b), 44, or 66(a) of the Act; and in § 2.86(c), amend to include the text in the last sentence of existing § 2.86(a)(3) regarding an applicant not claiming both section 1(a) and 1(b) of the Act for identical goods or services in a single application. The USPTO also proposes to add the following to § 2.86: in proposed § 2.86(d), restrict a single application from including goods or services in U.S. Classes A and/or B and either goods or services in any international class or with a collective membership organization in U.S. Class 200, for consistency with proposed § 2.45(f); in proposed § 2.86(e), add the text from existing § 2.86(b) regarding multiple-class requirements for amendments to allege use and statements of

use; and in § 2.86(f), add the text in existing § 2.86(c) regarding issuing a single registration certificate for multiple-class applications. Additionally, the USPTO proposes to amend the rule title to “Multiple-class applications.”

Post Notice of Allowance

The USPTO proposes to amend § 2.88, regarding statements of use, to include the relevant requirements for collective marks and certification marks, and to be consistent with proposed § 2.76 for amendments to allege use. Specifically, the USPTO proposes to amend § 2.88 as follows: in § 2.88(a), add the title “When to file a statement of use;” in § 2.88(a)(1) and (a)(2), include the text from existing § 2.88(a), except delete the language regarding the USPTO returning a premature statement of use filed prior to issuance of a notice of allowance because under current practice the USPTO will not return or review such amendment, and include the text from existing § 2.88(c), except for the last sentence; in § 2.88(b), add the title “A complete statement of use,” include in § 2.88 (b)(1)-(3) the text from existing § 2.88(b), in § 2.88(b)(1)(iii) additionally include the last sentence from existing § 2.88(c), in § 2.88(b)(1)(iv) additionally include the text from existing § 2.88(i)(1)-(2), in § 2.88 (b)(6) require the title “Statement of Use” on the first page of the document for those documents not filed using the TEAS, and in § 2.88(b) incorporate the requirements for collective marks and certification marks and change existing text to “verified statement” to correspond with § 2.2(n); in § 2.88(c), add the title “Minimum filing requirements for a timely filed statement of use,” include the text in existing § 2.88(e), and in § 2.88(c), change existing text to “verified statement” to correspond with § 2.2(n); in § 2.88(d), add the title “Deficiency notification” and include the text from existing § 2.88(g), except for the last sentence; in § 2.88(e), add the title “Notification of refusals and requirements” and include the text from existing § 2.88(f), except delete the language

regarding the USPTO providing notification of acceptance of a statement of use because the registration certificate provides such notice; in § 2.88(f), add the title “Statement of use may not be withdrawn” and include the text in the last sentence of existing § 2.88(g); in § 2.88(g), add the title “Verification not filed within reasonable time,” include the text from existing § 2.88(k), and change existing text to “verified statement” to correspond with § 2.2(n); in § 2.88(h), add the title “Amending the application,” include the text from the second to last sentence of existing § 2.88(f), and specify that statements of use may include amendments in accordance with § 2.51, § 2.59, and § 2.71 through § 2.75, as the TEAS on-line statement of use form will now accept such amendments within the same form; in § 2.88(i), add the requirements for the verification in a concurrent use application under § 2.42; in § 2.88(j), add the title “Multiple-class application” and include the text from existing § 2.88(l); and in § 2.88(k), add the title “Abandonment” and include the text from existing § 2.88(h). Additionally, the USPTO proposes to amend the rule title to “Statement of use after notice of allowance.”

The USPTO proposes to amend § 2.89, regarding submitting a request for an extension of time to file a statement of use (“extension request”), to include the relevant requirements for collective marks and certification marks as well as to make other changes consistent with current USPTO practice. The USPTO proposes to amend § 2.89 as follows: in § 2.89(a), add the title “First extension request after issuance of notice of allowance;” in § 2.89(a)(3), change existing text to “verified statement” to correspond with § 2.2(n), and incorporate the requirements for collective marks and certification marks; in § 2.89(b), add the title “Subsequent extension requests” and a cross-reference in proposed § 2.89(b)(2) to proposed § 2.89(a)(2), as the fee requirements are the same for first and subsequent extension requests; in § 2.89(c), add the title “Four subsequent extension requests permitted;” in § 2.89(d), add the title “Good cause,”

enumerate in proposed § 2.89(d)(1)-(3) the requirements for showing good cause for all marks, including collective marks and certification marks, and include the text from existing § 2.89(d) in (d)(1); in § 2.89(e), add the title “Extension request filed in conjunction with or after a statement of use” and amend the current text for clarity; in § 2.89(f), add the title “Goods or services” and incorporate the requirements for collective marks and certification marks; in § 2.89(g), add the title “Notice of grant or denial;” and in § 2.89(h), add the title “Verification not filed within reasonable time,” incorporate the requirements for collective marks and certification marks, and change existing text to “verified statement” to correspond with § 2.2(n).

Petitions and Action by the Director

The USPTO proposes to amend § 2.146(c), regarding petitions to the Director, to change existing text to “verified statements” to correspond with § 2.2(n). Additionally, the USPTO proposes to amend § 2.146(d) to specify that a petition regarding a cancelled or expired registration must be submitted to the Office within two months of the date when Office records are updated to show the registration as cancelled or expired, to ensure that all interested parties will be able to accurately determine the deadline for filing a petition under these circumstances.

Cancellation for Failure to File Affidavit or Declaration

The USPTO proposes to amend § 2.161, regarding affidavits or declarations of use in commerce or excusable nonuse under section 8 of the Act, to include the relevant requirements for collective marks and certification marks, to change existing text to correspond with § 2.2, and to make other changes consistent with current USPTO practice. The USPTO proposes to amend § 2.161(g) to cross-reference current § 2.56 regarding specimens and remove § 2.161(g)(1)-(3), as similar language appears in current § 2.56. The USPTO proposes to add § 2.161(i) and (j), as

follows, to include requirements for collective marks and certification marks to harmonize the USPTO's post registration practice with current examination practice, and to be consistent with proposed § 7.37(i)-(j), regarding affidavits or declarations of use in commerce or excusable nonuse under section 71 of the Act: in § 2.161(i), add the title "Additional requirements for a collective mark" and the additional requirements for such marks, see TMEP sections 1303.01, 1303.02(c)(i), 1304.08(f)(i)-(ii); in § 2.161(j), add the title "Additional requirements for a certification mark" and the additional requirements for such marks, see TMEP section 1306.06(f)(i)-(iii), (f)(v). The USPTO also proposes to add § 2.161(k) to cross-reference to § 7.37 regarding the requirements for a complete affidavit or declaration of use in commerce or excusable nonuse for a registration with an underlying application based on section 66(a). The sunset provision in current § 2.161(h)(3), in which § 2.161(h)(2) will no longer be applied after June 21, 2014, to affidavits or declarations filed under section 8 of the Act, is not altered by this rulemaking.

Affidavit or Declaration Under Section 15

The USPTO proposes to amend § 2.167, regarding an affidavit or declaration of incontestability under section 15 of the Act, to include the relevant requirements for collective marks and certification marks, to change existing text to "verified" to correspond with § 2.2(n), and to make other changes consistent with current USPTO practice. Specifically, the USPTO proposes to amend § 2.167(f) to delete the last sentence of the existing rule because, under current USPTO practice, notification acknowledging receipt of the affidavit or declaration only issues if the requirements of § 2.167(a) through (g) have been satisfied, consistent with proposed § 2.167(i). See TMEP section 1605. The USPTO also proposes to add § 2.167(h), (i), (j), and (k), as follows, to clarify current USPTO practice: in § 2.167(h), clarify that notification will be

provided to an owner that an affidavit or declaration cannot be acknowledged if the affidavit or declaration fails to satisfy any requirements in paragraphs § 2.167(a) through (g), that the affidavit or declaration will be abandoned if a response is not received in the time specified in the notification; in § 2.167(i), clarify that a notice of acknowledgement will only issue if an affidavit or declaration satisfies § 2.167(a) through (g); in § 2.167(j), clarify that an affidavit or declaration may be abandoned by petitioning the Director under § 2.146 either before or after a notice of acknowledgement issues; and in § 2.167(k), clarify that a new affidavit or declaration with a new fee may be filed if an affidavit or declaration is abandoned. See TMEP section 1605.

Correction, Disclaimer, Surrender, Etc.

The USPTO proposes to amend § 2.173, regarding an amendment to a registration, to include the relevant requirements for collective marks and certification marks, to change existing text to correspond with § 2.2, and to make other changes consistent with current USPTO practice. The USPTO proposes to make the following amendments to § 2.173: in § 2.173(b)(2), cross-reference § 2.193(e)(6), regarding trademark signature requirements, and delete the language in this subsection that is similar to wording in current § 2.193(e)(6); in § 2.173(d), clarify that an amendment that would materially alter the mark will not be permitted in accordance with section 7(e) of the Act; in § 2.173(e), amend the title to “Amendment of identification of goods, services, or collective membership organization,” and in the text of (e), add a reference to a description of the nature of the collective membership organization; and in § 2.173(f), amend the title to “Amendment of certification statement for certification marks” and set forth the prohibition regarding amending a certification statement, as specified in proposed § 2.45(a)(4)(i)(A) and (a)(4)(ii)(A), in accordance with section 7(e) of the Act and for consistency with proposed § 2.71(e). The USPTO proposes to redesignate current § 2.173(f) as

§ 2.173(g), and redesignate current § 2.173(g) as § 2.173(h). The USPTO also proposes to add § 2.173(i) with the heading “No amendment to add or delete a section 2(f) claim of acquired distinctiveness” to clarify that the USPTO will not permit an amendment seeking the addition or elimination of a claim of acquired distinctiveness, just as an owner cannot amend a registration from the Supplemental to the Principal Register. See TMEP section 1609.09.

The USPTO proposes to amend § 2.175(b)(2), regarding correcting an owner’s mistake, to change existing text to “verified” to correspond with § 2.2(n).

Term and Renewal

The USPTO proposes to amend § 2.183(d), regarding requirements for a renewal application, to specify that a renewal application may cover less than all the classes in a registration, in addition to covering less than all the goods or services in a registration.

General Information and Correspondence in Trademark Cases

The USPTO proposes to amend § 2.193, regarding trademark correspondence and signature requirements, to correct a typographical error in § 2.193(c)(2), to change existing text in § 2.193(e)(1) to correspond with § 2.2(n), and to revise the final sentence of § 2.193(f) to delete reference to § 10.23(c)(15) and instead refer to § 11.804, as part 10 of this chapter has been removed and reserved and the content in § 11.804 corresponds with content previously set out in § 10.23.

PART 7: RULES OF PRACTICE IN FILINGS PURSUANT TO THE PROTOCOL
RELATING TO THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL
REGISTRATION OF MARKS

Subpart A – General Information

The USPTO proposes to amend § 7.1, regarding definitions, to add § 7.1(f), which incorporates by reference the definitions in proposed § 2.2(k) and (n), to apply to filings pursuant to the Protocol relating to the Madrid Agreement concerning the international registration of marks.

Subpart F – Affidavit Under Section 71 of the Act for Extension of Protection to the United States

The USPTO proposes to amend § 7.37, regarding affidavits or declarations of use in commerce or excusable nonuse under section 71 of the Act, to include the relevant requirements for collective marks and certification marks and to change existing text to correspond with § 2.2. Specifically, the USPTO proposes to add § 7.37(i) and (j) as follows, to include requirements for collective marks and certification marks so as to harmonize the USPTO’s post registration practice with current examination practice, and to be consistent with proposed § 2.161(i)-(j), regarding affidavits or declarations of use in commerce or excusable nonuse under section 8 of the Act: in proposed § 7.37(i), add the title “Additional requirements for a collective mark” and the additional requirements for such marks, see TMEP sections 1303.01, 1303.02(c)(i), 1304.08(f)(i)-(ii), 1904.02(d); in proposed § 7.37(j), add the title “Additional requirements for a certification mark” and additional requirements for such marks, see TMEP sections 1306.06(f)(i)-(iii), (f)(v), 1904.02(d). The sunset provision in current § 7.37(h)(3), in which

§ 7.37(h)(2) will no longer be applied after June 21, 2014, to affidavits or declarations filed under section 71 of the Act, is not altered by this rulemaking.

Rulemaking Considerations

Administrative Procedure Act: The changes in this proposed rulemaking involve rules of agency practice and procedure, and/or interpretive rules. See Nat'l Org. of Veterans' Advocates v. Sec'y of Veterans Affairs, 260 F.3d 1365, 1375 (Fed. Cir. 2001) (rule that clarifies interpretation of a statute is interpretive); Bachow Commc'ns Inc. v. FCC, 237 F.3d 683, 690 (D.C. Cir. 2001) (rules governing an application process are procedural under the Administrative Procedure Act); Inova Alexandria Hosp. v. Shalala, 244 F.3d 342, 350 (4th Cir. 2001) (rules for handling appeals were procedural where they did not change the substantive standard for reviewing claims).

Accordingly, prior notice and opportunity for public comment for the changes in this proposed rulemaking are not required pursuant to 5 U.S.C. 553(b) or (c), or any other law. See Cooper Techs. Co. v. Dudas, 536 F.3d 1330, 1336-37 (Fed. Cir. 2008) (stating that 5 U.S.C. 553, and thus 35 U.S.C. 2(b)(2)(B), does not require notice and comment rulemaking for “interpretative rules, general statements of policy, or rules of agency organization, procedure, or practice,” quoting 5 U.S.C. 553(b)(A)). The USPTO, however, is publishing these proposed rule changes for comment as it seeks the benefit of the public's views regarding collective and certification marks.

Regulatory Flexibility Act: As prior notice and an opportunity for public comment are not required pursuant to 5 U.S.C. 553 or any other law, neither a Regulatory Flexibility Act

analysis, nor a certification under the Regulatory Flexibility Act (5 U.S.C. 601, et seq.), is required. See 5 U.S.C. 603.

In addition, for the reasons set forth herein, the Deputy General Counsel for General Law of the United States Patent and Trademark Office (USPTO) has certified to the Chief Counsel for Advocacy of the Small Business Administration that rule changes proposed in this document will not have a significant economic impact on a substantial number of small entities. See 5 U.S.C. 605(b).

To the extent the rule changes proposed in this document primarily codify existing USPTO practice set forth in the TMEP and precedential case law regarding collective marks and certification marks, those proposed rule changes impose no new burdens on applicants and registration owners. Some rule changes have been proposed to harmonize registration maintenance requirements with current application requirements. The USPTO also has proposed to change existing practice regarding maintenance requirements regarding certification marks to require filers of the first affidavit of use after registration in registrations based on Trademark Act Sections 44 and 66(a) to submit certification standards, and to require that all filers of such affidavits submit updated standards if the standards have changed or a statement indicating they have not. The USPTO does not collect or maintain statistics in trademark cases on small versus large entity applicants, and this information would be required in order to precisely calculate the number of small entities that would be affected. However, these proposed rule changes will have no impact on the vast majority of trademark owners, and only a slight effect on the very small subset of certification mark registrations, where standards previously have not been provided, or change post registration. Certification marks account for approximately 0.2% of the total number of registered marks in the USPTO database (approximately 4,000 registrations out of a

total of approximately 2,000,000 registrations). For fiscal year 2013, affidavits of use for all filers have totaled approximately 170,000 of which approximately 0.2%, or 340 affidavits, were submitted for certification mark registrations. Of those 340 affidavits, only a small subset will be required to include certification standards or revised standards. Even in the event that standards must be submitted, the burden is quite minimal, as it merely involves attaching an already existing document to a filing that must otherwise be made to maintain the registration. For these reasons, the proposed rule changes will not have a significant economic impact on a substantial number of small entities.

Executive Order 12866 (Regulatory Planning and Review): The proposed rulemaking has been determined to be not significant for purposes of Executive Order 12866 (Sept. 30, 1993).

Executive Order 13563 (Improving Regulation and Regulatory Review): The USPTO has complied with Executive Order 13563 (Jan. 18, 2011). Specifically, the USPTO has, to the extent feasible and applicable: (1) made a reasoned determination that the benefits justify the costs of the proposed rule changes; (2) tailored the proposed rules to impose the least burden on society consistent with obtaining the regulatory objectives; (3) selected a regulatory approach that maximizes net benefits; (4) specified performance objectives; (5) identified and assessed available alternatives; (6) provided the public with a meaningful opportunity to participate in the regulatory process, including soliciting the views of those likely affected prior to issuing a notice of proposed rulemaking, and provided on-line access to the rulemaking docket; (7) attempted to promote coordination, simplification, and harmonization across government agencies and identified goals designed to promote innovation; (8) considered approaches that reduce burdens

and maintain flexibility and freedom of choice for the public; and (9) ensured the objectivity of scientific and technological information and processes, to the extent applicable.

Executive Order 13132 (Federalism): This proposed rulemaking does not contain policies with federalism implications sufficient to warrant preparation of a Federalism Assessment under Executive Order 13132 (Aug. 4, 1999).

Congressional Review Act: Under the Congressional Review Act provisions of the Small Business Regulatory Enforcement Fairness Act of 1996 (5 U.S.C. 801 *et seq.*), prior to issuing any final rule, the USPTO will submit a report containing the final rule and other required information to the U.S. Senate, the U.S. House of Representatives, and the Comptroller General of the Government Accountability Office. The changes proposed in this document are not expected to result in an annual effect on the economy of 100 million dollars or more, a major increase in costs or prices, or significant adverse effects on competition, employment, investment, productivity, innovation, or the ability of United States-based enterprises to compete with foreign-based enterprises in domestic and export markets. Therefore, this document is not expected to result in a “major rule” as defined in 5 U.S.C. 804(2).

Unfunded Mandates Reform Act of 1995: The changes set forth in this proposed rulemaking do not involve a Federal intergovernmental mandate that will result in the expenditure by State, local, and tribal governments, in the aggregate, of 100 million dollars (as adjusted) or more in any one year, or a Federal private sector mandate that will result in the expenditure by the private sector of 100 million dollars (as adjusted) or more in any one year, and will not significantly or uniquely affect small governments. Therefore, no actions are

necessary under the provisions of the Unfunded Mandates Reform Act of 1995. See 2 U.S.C. 1501 et seq.

Paperwork Reduction Act: This proposed rulemaking involves information collection requirements which are subject to review by the U.S. Office of Management and Budget (OMB) under the Paperwork Reduction Act of 1995 (44 U.S.C. 3501 et seq.). The USPTO has determined that there would be no new information collection requirements or impacts to existing information collection requirements associated with this proposed rulemaking. The collections of information involved in this proposed rulemaking have been reviewed and previously approved by OMB under control numbers 0651-0009, 0651-0050, 0651-0051, 0651-0054, 0651-0055, 0651-0056, and 0651-0061.

Notwithstanding any other provision of law, no person is required to respond to, nor shall a person be subject to a penalty for failure to comply with, a collection of information subject to the requirements of the Paperwork Reduction Act unless that collection of information displays a currently valid OMB control number.

List of Subjects

37 CFR Part 2

Administrative practice and procedure, Trademarks.

37 CFR Part 7

Administrative practice and procedure, Trademarks, International Registration.

For the reasons given in the preamble and under the authority contained in 15 U.S.C. 1123 and 35 U.S.C. 2, as amended, the USPTO proposes to amend parts 2 and 7 of title 37 as follows:

PART 2 RULES OF PRACTICE IN TRADEMARK CASES

1. The authority citation for 37 CFR part 2 continues to read as follows:

Authority: 15 U.S.C. 1123, 35 U.S.C. 2, unless otherwise noted.

2. Amend § 2.2 as follows:

a. Revise paragraphs (f) and (h).

b. Add paragraphs (i) through (n).

§ 2.2 Definitions.

* * * * *

(f) The acronym TEAS means the Trademark Electronic Application System, available at <http://www.uspto.gov>.

* * * * *

(h) The term international application as used in this part means an application seeking an extension of protection of an international registration to the United States or a subsequent designation of the international registration to the United States, and is filed under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks. See section 60 of the Act.

(i) The term subsequent designation as used in this part means a request for extension of protection of an international registration to the United States made after the International Bureau registers the mark.

(j) The term holder as used in this part means the natural or juristic person in whose name an international registration seeking an extension of protection to the United States is recorded on the International Register. See section 60 of the Act.

(k) The term use in commerce as used in this part means, in addition to the definition in section 45 of the Act:

(1) For a trademark or service mark, use of the mark in commerce by an applicant or owner on or in connection with the goods or services specified in a U.S. application, amendment to allege use, statement of use, or affidavit or declaration of use or excusable nonuse;

(2) For a collective trademark or collective service mark, use of the mark in commerce by members on or in connection with the goods or services specified in a U.S. application, amendment to allege use, statement of use, or affidavit or declaration of use or excusable nonuse;

(3) For a collective membership mark, use of the mark in commerce by members to indicate membership in the collective organization as specified in a U.S. application, amendment to allege use, statement of use, or affidavit or declaration of use or excusable nonuse; and

(4) For a certification mark, use of the mark in commerce by authorized users on or in connection with the goods or services specified in a U.S. application, amendment to allege use, statement of use, or affidavit or declaration of use or excusable nonuse.

(l) The term bona fide intention to use the mark in commerce as used in this part means, for a trademark or service mark, that an applicant or holder has a bona fide intention to use the mark in commerce on or in connection with the goods or services specified in a U.S. application or international application.

(m) The term bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce as used in this part means:

(1) For a collective trademark or collective service mark, that an applicant or holder has a bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in

commerce by members on or in connection with the goods or services specified in a U.S. application or international application;

(2) For a collective membership mark, that an applicant or holder has a bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce by members to indicate membership in the collective organization as specified in a U.S. application or international application; and

(3) For a certification mark, that an applicant or holder has a bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce by authorized users on or in connection with the goods or services specified in a U.S. application or international application.

(n) The term verified statement, and the terms verify, verified, or verification as used in this part refers to a statement that is sworn to, made under oath or in an affidavit, or supported by a declaration under § 2.20 or 28 U.S.C. 1746, and signed in accordance with the requirements of § 2.193.

3. Revise the introductory text to § 2.20 to read as follows:

§ 2.20 Declarations in lieu of oaths.

Instead of an oath, affidavit, or sworn statement, the language of 28 U.S.C. 1746, or the following declaration language, may be used:

* * * * *

4. Amend § 2.32 as follows:

a. Revise the section heading and paragraphs (a)(3)(ii), (a)(6), and (c).

b. Add paragraphs (f) and (g).

§ 2.32 Requirements for a complete trademark or service mark application.

(a) * * *

(3) * * *

(iii) If the applicant is a domestic partnership, the names and citizenship of the general partners; or

* * * * *

(6) A list of the particular goods or services on or in connection with which the applicant uses or intends to use the mark. In a U.S. application filed under section 44 of the Act, the scope of the goods or services covered by the section 44 basis may not exceed the scope of the goods or services in the foreign application or registration;

* * * * *

(c) The application must include a drawing that meets the requirements of § 2.51 and § 2.52.

* * * * *

(e) For the requirements of a multiple-class application, see § 2.86.

(f) For the requirements of all collective mark applications, see § 2.44.

(g) For the requirements of a certification mark application, see § 2.45.

5. Revise § 2.33 to read as follows:

§ 2.33 Verified statement for a trademark or service mark.

(a) The application must include a verified statement.

(b)(1) In an application under section 1(a) of the Act, the verified statement must allege:

That the applicant believes the applicant is the owner of the mark; that the mark is in use in commerce; that to the best of the signatory's knowledge and belief, no other person has the right to use the mark in commerce, either in the

identical form or in such near resemblance as to be likely, when applied to the goods or services of such other person, to cause confusion or mistake, or to deceive; that the specimen shows the mark as used on or in connection with the goods or services; and that the facts set forth in the application are true.

(2) In an application under section 1(b) or 44 of the Act, the verified statement must allege:

That the applicant has a bona fide intention to use the mark in commerce; that the applicant believes the applicant is entitled to use the mark in commerce on or in connection with the goods or services specified in the application; that to the best of the signatory's knowledge and belief, no other person has the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when applied to the goods or services of such other person, to cause confusion or mistake, or to deceive; and that the facts set forth in the application are true.

(c) If the verified statement in paragraph (b)(1) or (b)(2) of this section is not filed within a reasonable time after it is signed, the Office may require the applicant to submit a substitute verified statement attesting, as of the filing date, that the mark has been in use in commerce or the applicant has had a bona fide intention to use the mark in commerce.

(d) [Reserved]

(e) In an application under section 66(a) of the Act, the verified statement, which is part of the international registration on file with the International Bureau, must allege that:

(1) The applicant/holder has a bona fide intention to use the mark in commerce;

(2) The signatory is properly authorized to execute the declaration on behalf of the applicant/holder;

(3) The signatory believes the applicant/holder to be entitled to use the mark in commerce that the U.S. Congress can regulate on or in connection with the goods or services specified in the international application/registration; and

(4) To the best of his/her knowledge and belief, no other person, firm, corporation, association, or other legal entity has the right to use the mark in commerce either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods or services of such other person, firm, corporation, association, or other legal entity, to cause confusion, or to cause mistake, or to deceive.

(f) In an application for concurrent use under § 2.42, the verified statement in paragraph (b)(1) of this section must be modified to indicate that no other person except as specified in the application has the right to use the mark in commerce.

6. Amend § 2.34 as follows:

a. Revise the section heading and paragraphs (a) introductory text, (a)(1) introductory text, (a)(1)(i), (a)(1)(iii) through (a)(1)(v), (a)(2), (a)(3) introductory text, (a)(3)(i), (a)(3)(iii), (a)(4) introductory text, (a)(4)(i)(B), (a)(4)(ii), (a)(4)(iii), (a)(5), and (b); and

b. Remove paragraph (c).

§ 2.34 Bases for filing a trademark or service mark application.

(a) An application for a trademark or service mark must include one or more of the following five filing bases:

(1) Use in commerce under section 1(a) of the Act. The requirements for an application under section 1(a) of the Act are:

(i) The applicant's verified statement that the mark is in use in commerce. If the verified statement is not filed with the initial application, the verified statement must also allege that the mark has been in use in commerce as of the application filing date;

* * * * *

(iii) The date of the applicant's first use of the mark in commerce;

(iv) One specimen showing how the applicant uses the mark in commerce; and

(v) If the application specifies more than one item of goods or services in a class, the dates of use in paragraphs (a)(1)(ii) and (iii) of this section are required for only one item of goods or services specified in that class.

(2) Intent-to-use under section 1(b) of the Act. In an application under section 1(b) of the Act, the applicant must verify that the applicant has a bona fide intention to use the mark in commerce. If the verified statement is not filed with the initial application, the verified statement must also allege that the applicant has had a bona fide intention to use the mark in commerce as of the application filing date.

(3) Registration of a mark in a foreign applicant's country of origin under section 44(e) of the Act. The requirements for an application under section 44(e) of the Act are:

(i) The applicant's verified statement that the applicant has a bona fide intention to use the mark in commerce. If the verified statement is not filed with the initial application, the Office will require submission of the verified statement, which must also allege that the applicant has had a bona fide intention to use the mark in commerce as of the application filing date.

* * * * *

(iii) If the record indicates that the foreign registration will expire before the U.S. registration will issue, the applicant must submit a true copy, a photocopy, a certification, or a

certified copy of a proof of renewal from the applicant's country of origin to establish that the foreign registration has been renewed and will be in full force and effect at the time the U.S. registration will issue. If the proof of renewal is not in the English language, the applicant must submit a translation.

(4) Claim of priority, based upon an earlier-filed foreign application, under section 44(d) of the Act. The requirements for an application under section 44(d) of the Act are:

(i) * * *

(B) State that the application is based upon a subsequent regularly filed application in the same foreign country, and that any prior-filed application has been withdrawn, abandoned, or otherwise disposed of, without having been laid open to public inspection and without having any rights outstanding, and has not served as a basis for claiming a right of priority.

(ii) The applicant's verified statement that the applicant has a bona fide intention to use the mark in commerce. If the verified statement is not filed with the initial application, the Office will require submission of the verified statement, which must also allege that the applicant has had a bona fide intention to use the mark in commerce as of the application filing date.

(iii) Before the application can be approved for publication, or for registration on the Supplemental Register, the applicant must establish a basis under section 1 or 44 of the Act.

(5) Extension of protection of an international registration under section 66(a) of the Act. In an application under section 66(a) of the Act, the international application or subsequent designation requesting an extension of protection to the United States must contain a signed declaration that meets the requirements of § 2.33(a), (e).

(b) More than one basis. In an application under section 1 or 44 of the Act, an applicant may claim more than one basis, provided the applicant satisfies all requirements for the bases

claimed. In such case, the applicant must specify each basis, followed by the goods or services to which that basis applies. An applicant must specify the goods or services covered by more than one basis. Section 1(a) and 1(b) of the Act may not both be claimed for identical goods or services in the same application. A basis under section 66(a) of the Act may not be combined with another basis.

7. Revise § 2.41 to read as follows:

§ 2.41 Proof of distinctiveness under section 2(f).

(a) For a trademark or service mark -- (1) Ownership of prior registration(s). In appropriate cases, ownership of one or more prior active registrations on the Principal Register or under the Trademark Act of 1905 of the same mark may be accepted as prima facie evidence of distinctiveness if the goods or services are sufficiently similar to the goods or services in the application; however, further evidence may be required.

(2) Five years substantially exclusive and continuous use in commerce. In appropriate cases, if a trademark or service mark is said to have become distinctive of the applicant's goods or services by reason of the applicant's substantially exclusive and continuous use of the mark in commerce for the five years before the date on which the claim of distinctiveness is made, a showing by way of verified statements in the application may be accepted as prima facie evidence of distinctiveness; however, further evidence may be required.

(3) Other evidence. When registration is sought for a trademark or service mark that would be unregistrable by reason of section 2(e) of the Act, but which is said by the applicant to have become distinctive in commerce of the applicant's goods or services, the applicant may, in support of registrability, submit with the application, or in response to a request for evidence or to a refusal to register, verified statements, depositions, or other appropriate evidence showing

duration, extent, and nature of the use in commerce and advertising expenditures in connection therewith (identifying types of media and attaching typical advertisements), and verified statements, letters or statements from the trade or public, or both, or other appropriate evidence of distinctiveness.

(b) For a collective trademark or collective service mark -- (1) Ownership of prior registration(s). See the requirements of paragraph (a)(1) of this section.

(2) Five years substantially exclusive and continuous use in commerce. In appropriate cases, if a collective trademark or collective service mark is said to have become distinctive of the members' goods or services by reason of the members' substantially exclusive and continuous use of the mark in commerce for the five years before the date on which the claim of distinctiveness is made, a showing by way of verified statements in the application may be accepted as prima facie evidence of distinctiveness; however, further evidence may be required.

(3) Other evidence. When registration is sought for a collective trademark or service mark that would be unregistrable by reason of section 2(e) of the Act, but which is said by the applicant to have become distinctive in commerce of the members' goods or services, the applicant may, in support of registrability, submit with the application, or in response to a request for evidence or to a refusal to register, verified statements, depositions, or other appropriate evidence showing duration, extent, and nature of the use in commerce, and advertising expenditures in connection therewith (identifying types of media and attaching typical advertisements), and verified statements, letters or statements from the trade or public, or both, or other appropriate evidence of distinctiveness.

(c) For a collective membership mark -- (1) Ownership of prior registration(s). In appropriate cases, ownership of one or more prior active registrations on the Principal Register

or under the Act of 1905 of the same mark may be accepted as prima facie evidence of distinctiveness if the goods, services, or nature of the collective membership organization are sufficiently similar to the collective membership organization in the application; however, further evidence may be required.

(2) Five years substantially exclusive and continuous use in commerce. In appropriate cases, if a collective membership mark is said to have become distinctive of indicating membership in the applicant's collective membership organization by reason of the members' substantially exclusive and continuous use of the mark in commerce for the five years before the date on which the claim of distinctiveness is made, a showing by way of verified statements in the application may be accepted as prima facie evidence of distinctiveness; however, further evidence may be required.

(3) Other evidence. When registration is sought for a collective membership mark that would be unregistrable by reason of section 2(e) of the Act, but which is said by the applicant to have become distinctive in commerce of indicating membership in the applicant's collective membership organization, the applicant may, in support of registrability, submit with the application, or in response to a request for evidence or to a refusal to register, verified statements, depositions, or other appropriate evidence showing duration, extent, and nature of the members' use in commerce, and advertising expenditures in connection therewith (identifying types of media and attaching typical advertisements), and verified statements, letters or statements from the trade or public, or both, or other appropriate evidence of distinctiveness.

(d) For a certification mark -- (1) Ownership of prior certification mark registration(s). In appropriate cases, ownership of one or more prior active certification mark registrations on the Principal Register or under the Act of 1905 of the same mark may be accepted as prima facie

evidence of distinctiveness if the authorized users' goods or services are sufficiently similar to the goods or services certified in the application, subject to the limitations of the statement set forth in § 2.45(a)(4)(i)(C); however, further evidence may be required.

(2) Five years substantially exclusive and continuous use in commerce. In appropriate cases, if a certification mark is said to have become distinctive of the certified goods or services by reason of the authorized users' substantially exclusive and continuous use of the mark in commerce for the five years before the date on which the claim of distinctiveness is made, a showing by way of verified statements in the application may be accepted as prima facie evidence of distinctiveness; however, further evidence may be required.

(3) Other evidence. When registration is sought for a certification mark that would be unregistrable by reason of section 2(e) of the Act, but which is said by the applicant to have become distinctive of the certified goods or services program, the applicant may, in support of registrability, submit with the application, or in response to a request for evidence or to a refusal to register, verified statements, depositions, or other appropriate evidence showing duration, extent, and nature of the authorized users' use in commerce and advertising expenditures in connection therewith (identifying types of media and attaching typical advertisements), and verified statements, letters or statements from the trade or public, or both, or other appropriate evidence of distinctiveness.

(e) Paragraph (d) does not apply to geographical matter in a certification mark pursuant to section 2(e)(2) of the Act.

8. Revise § 2.42 to read as follows:

§ 2.42 Concurrent use.

(a) Prior to seeking concurrent use, an application for registration on the Principal Register under the Act must assert use in commerce and include all the application elements required by the preceding sections, in addition to § 2.44 or § 2.45, if applicable.

(b) The applicant must also include a verified statement that indicates the following, to the extent of the applicant's knowledge:

(1) For a trademark or service mark, the geographic area in which the applicant is using the mark in commerce; for a collective mark or certification mark, the geographic area in which the applicant's members or authorized users are using the mark in commerce;

(2) For a trademark or service mark, the applicant's goods or services; for a collective trademark, collective service mark, or certification mark, the applicant's members' or authorized users' goods or services; for a collective membership mark, the nature of the applicant's collective membership organization;

(3) The mode of use for which the applicant seeks registration;

(4) The concurrent users' names and addresses;

(5) The registrations issued to or applications filed by such concurrent users, if any;

(6) For a trademark or service mark, the geographic areas in which the concurrent user is using the mark in commerce; for a collective mark or certification mark, the geographic areas in which the concurrent user's members or authorized users are using the mark in commerce;

(7) For a trademark or service mark, the concurrent user's goods or services; for a collective trademark, collective service mark, or certification mark, the concurrent user's members' or authorized users' goods or services; for a collective membership mark, the nature of the concurrent user's collective membership organization;

(8) The mode of use by the concurrent users or the concurrent users' members or authorized users; and

(9) The time periods of such use by the concurrent users or the concurrent users' members or authorized users.

(c) For the requirements to amend an application to concurrent use, see § 2.73.

(d) For the requirements of a concurrent use proceeding, see § 2.99.

9. Revise § 2.44 to read as follows:

§ 2.44 Requirements for a complete collective mark application.

(a) A complete application to register a collective trademark, collective service mark, or collective membership mark must include the following:

(1) The requirements specified in § 2.32 (a) introductory text-(a)(4), (a)(8)-(10), (c)-(d);

(2)(i) For a collective trademark or collective service mark, a list of the particular goods or services on or in connection with which the applicant's members use or intend to use the mark; or

(ii) For a collective membership mark, a description of the nature of the membership organization such as by type, purpose, or area of activity of the members; and

(iii) In a U.S. application filed under section 44 of the Act, the scope of the goods or services or the nature of the membership organization covered by the section 44 basis may not exceed the scope of the goods or services or nature of the membership organization in the foreign application or registration.

(3)(i) For a collective trademark or collective service mark application, the international class of goods or services, if known. See § 6.1 of this chapter for a list of the international classes of goods and services; or

(ii) For a collective membership mark application filed under sections 1 or 44 of the Act, classification in U.S. Class 200; and for a collective membership mark application filed under section 66(a) of the Act, the international class(es) assigned by the International Bureau in the corresponding international registration.

(4) One or more of the following five filing bases:

(i) Use in commerce under section 1(a) of the Act. The requirements for an application under section 1(a) of the Act are:

(A) A statement specifying the nature of the applicant's control over the use of the mark by the members;

(B) For a collective trademark or collective service mark, the date of the applicant's member's first use of the mark anywhere on or in connection with the goods or services and the date of the applicant's member's first use of the mark in commerce; or for a collective membership mark, the date of the applicant's member's first use anywhere to indicate membership in the collective organization and the date of the applicant's member's first use in commerce. If the application specifies more than one item of goods or services in a class, the dates of use are required for only one item of goods or services specified in that class;

(C) One specimen showing how a member uses the mark in commerce; and

(D) A verified statement alleging:

That the applicant believes the applicant is the owner of the mark; that the mark is in use in commerce; that the applicant is exercising legitimate control over the use of the mark in commerce by members on or in connection with the goods, services, or collective membership organization specified in the application; that to the best of the signatory's knowledge and belief, no other persons except members have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods, services, or collective membership organization of such other persons to cause confusion or mistake, or to deceive; that the specimen

shows the mark as used in commerce by the applicant's members; and that the facts set forth in the application are true.

(ii) Intent-to-use under section 1(b) of the Act. The requirement for an application based on section 1(b) of the Act is a verified statement alleging:

That the applicant has a bona fide intention, and is entitled, to exercise legitimate control over the use in commerce of the mark; that to the best of the signatory's knowledge and belief, no other persons, except members, have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods, services, or collective membership organization of such other persons, to cause confusion or mistake, or to deceive; and that the facts set forth in the application are true.

(iii) Registration of a mark in a foreign applicant's country of origin under section 44(e) of the Act. The requirements for an application under section 44(e) of the Act are:

(A) The requirements of § 2.34(a)(3)(ii)-(iii); and

(B) A verified statement in accordance with paragraph (a)(4)(ii) of this section.

(iv) Claim of priority, based upon an earlier-filed foreign application, under section 44(d) of the Act. The requirements for an application under section 44(d) of the Act are:

(A) The requirements of § 2.34(a)(4)(i), (iii); and

(B) A verified statement in accordance with paragraph (a)(4)(ii) of this section.

(v) Extension of protection of an international registration under section 66(a) of the Act.

The requirement for an application under section 66(a) of the Act is a verified statement, which is part of the international registration on file with the International Bureau, alleging that:

(A) The applicant/holder has a bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce;

(B) The signatory is properly authorized to execute the declaration on behalf of the applicant/holder; and

(C) to the best of his/her knowledge and belief, no other person, firm, corporation, association, or other legal entity, except members, has the right to use the mark in commerce either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods, services, or collective membership organization of such other person, firm, corporation, association, or other legal entity, to cause confusion, or to cause mistake, or to deceive.

(b) Verification not filed within reasonable time or omitted -- (1) If the verified statement in paragraph (a)(4)(i)(D), (a)(4)(ii), (a)(4)(iii)(B), or (a)(4)(iv)(B) of this section is not filed within a reasonable time after it is signed, the Office may require a substitute verified statement attesting, as of the application filing date, that the mark has been in use in commerce or the applicant has had a bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce; or

(2) If the verified statement in paragraph (a)(4)(i)(D), (a)(4)(ii), (a)(4)(iii)(B), or (a)(4)(iv)(B) of this section is not filed with the initial application, the verified statement must also allege that, as of the application filing date, the mark has been in use in commerce, or the applicant has had a bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce.

(c) More than one basis. In an application under section 1 or 44 of the Act, an applicant may claim more than one basis, provided the applicant satisfies all requirements for the bases

claimed. In such case, the applicant must specify each basis, followed by the goods or services to which that basis applies. An applicant must specify the goods or services covered by more than one basis. Section 1(a) and 1(b) of the Act may not both be claimed for identical goods or services in the same application. A basis under section 66(a) of the Act may not be combined with another basis.

(d) In an application for concurrent use under § 2.42, the verified statement in paragraph (a)(4)(i)(D) of this section must be modified to indicate that no other persons except members and the concurrent users as specified in the application have the right to use the mark in commerce.

(e) Multiple-class applications. For the requirements of a multiple-class application, see § 2.86.

10. Revise § 2.45 to read as follows:

§ 2.45 Requirements for a complete certification mark application; restriction on certification mark application.

(a) A complete application to register a certification mark must include the following:

(1) The requirements specified in § 2.32 (a) introductory text-(a)(4), (a)(8)-(10), (c)-(d);

(2) A list of the particular goods or services on or in connection with which the applicant's authorized users use or intend to use the mark. In an application filed under section 44 of the Act, the scope of the goods or services covered by the section 44 basis may not exceed the scope of the goods or services in the foreign application or registration;

(3) For applications filed under section 1 or 44 of the Act, classification in U.S. Class A for an application certifying goods and U.S. Class B for an application certifying services. For

applications filed under section 66(a) of the Act, the international class(es) of goods or services assigned by the International Bureau in the corresponding international registration;

(4) One or more of the following five filing bases:

(i) Use in commerce under section 1(a) of the Act. The requirements for an application under section 1(a) of the Act are:

(A) A statement specifying what the applicant is certifying about the goods or services in the application;

(B) A copy of the certification standards governing use of the certification mark on or in connection with the goods or services specified in the application;

(C) A statement that the applicant is not engaged in the production or marketing of the goods or services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods or services that meet the certification standards of the applicant;

(D) The date of the applicant's authorized user's first use of the mark anywhere on or in connection with the goods or services and the date of the applicant's authorized user's first use of the mark in commerce. If the application specifies more than one item of goods or services in a class, the dates of use are required for only one item of goods or services specified in that class;

(E) One specimen showing how an authorized user uses the mark in commerce; and

(F) A verified statement alleging:

That the applicant believes the applicant is the owner of the mark; that the mark is in use in commerce; that the applicant is exercising legitimate control over the use of the mark in commerce by authorized users on or in connection with the goods or services specified in the application; that to the best of the

signatory's knowledge and belief, no other persons except authorized users have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods or services of such other persons, to cause confusion or mistake, or to deceive; that the specimen shows the mark as used in commerce by the applicant's authorized users; and that the facts set forth in the application are true.

(ii) Intent-to-use under section 1(b) of the Act. The requirements for an application based on section 1(b) of the Act are:

(A) A statement specifying what the applicant will be certifying about the goods or services;

(B) A statement that the applicant will not engage in the production or marketing of the goods or services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods or services that meet the certification standards of the applicant; and

(C) A verified statement alleging:

That the applicant has a bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce; that to the best of the signatory's knowledge and belief, no other persons, except authorized users, have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods or services of such other persons, to cause confusion or mistake, or to deceive; and that the facts set forth in the application are true.

(iii) Registration of a mark in a foreign applicant's country of origin under section 44(e) of the Act. The requirements for an application under section 44(e) of the Act are:

- (A) The requirements of § 2.34(a)(3)(ii)-(iii);
- (B) The requirements of § 2.45(a)(4)(ii)(A), (B); and
- (C) A verified statement in accordance with § 2.45(a)(4)(ii)(C).

(iv) Claim of priority, based upon an earlier-filed foreign application, under section 44(d) of the Act. The requirements for an application under section 44(d) of the Act are:

- (A) The requirements of § 2.34(a)(4)(i), (iii);
- (B) The requirements of § 2.45(a)(4)(ii)(A), (B); and
- (C) A verified statement in accordance with § 2.45(a)(4)(ii)(C).

(v) Extension of protection of an international registration under section 66(a) of the Act.

The requirements for an application under section 66(a) of the Act are:

- (A) The requirements of § 2.45(a)(4)(ii)(A), (B); and
- (B) A verified statement, which is part of the international registration on file with the

International Bureau, alleging that:

(1) The applicant/holder has a bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce;

(2) The signatory is properly authorized to execute the declaration on behalf of the applicant/holder; and

(3) To the best of his/her knowledge and belief, no other person, firm, corporation, association, or other legal entity, except authorized users, has the right to use the mark in commerce either in the identical form thereof or in such near resemblance thereto as to be likely,

when used on or in connection with the goods or services of such other person, firm, corporation, association, or other legal entity, to cause confusion, or to cause mistake, or to deceive.

(b) Verification not filed within reasonable time or omitted -- (1) If the verified statement in paragraph (a)(4)(i)(F), (a)(4)(ii)(C), (a)(4)(iii)(C), or (a)(4)(iv)(C) of this section is not filed within a reasonable time after it is signed, the Office may require the applicant to submit a substitute verified statement attesting that, as of the application filing date, the mark has been in use in commerce or the applicant has had a bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce; or

(2) If the verified statement in paragraph (a)(4)(i)(F), (a)(4)(ii)(C), (a)(4)(iii)(C), or (a)(4)(iv)(C) of this section is not filed with the initial application, the verified statement must also allege that, as of the application filing date, the mark has been in use in commerce, or the applicant has had a bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce.

(c) More than one basis. In an application under section 1 or 44 of the Act, an applicant may claim more than one basis, provided the applicant satisfies all requirements for the bases claimed. In such case, the applicant must specify each basis, followed by the goods or services to which that basis applies. An applicant must specify the goods or services covered by more than one basis. Section 1(a) and 1(b) of the Act may not both be claimed for identical goods or services in the same application. A basis under section 66(a) of the Act may not be combined with another basis.

(d) Concurrent use. In an application for concurrent use under § 2.42, the verified statement in paragraph (a)(4)(i)(F) of this section must be modified to indicate that no other

persons except authorized users and concurrent users as specified in the application have the right to use the mark in commerce.

(e) Multiple-class applications. For the requirements of a multiple-class application, see § 2.86.

(f) Restriction on certification mark application. A single application may not include a certification mark and another type of mark. The same mark for the same goods or services is not registrable as both a certification mark and another type of mark. See sections 4 and 14(5)(B) of the Act.

11. Amend § 2.56 by revising paragraphs (b)(2), (b)(5), (c), and (d)(3) to read as follows:

§ 2.56 Specimens.

* * * * *

(b) * * *

(2) A service mark specimen must show the mark as used in the sale or advertising of the services.

* * * * *

(5) A certification mark specimen must show how a person other than the owner uses the mark to reflect certification of regional or other origin, material, mode of manufacture, quality, accuracy, or other characteristics of that person's goods or services; or that members of a union or other organization performed the work or labor on the goods or services.

(c) A photocopy or other reproduction of a specimen of the mark as used on or in connection with the goods, or in the sale or advertising of the services, is acceptable. However, a photocopy of the drawing required by § 2.51 is not a proper specimen.

* * * * *

(d) * * *

(3) In the absence of non-bulky alternatives, the Office may accept a compact disc, digital video disc, or other appropriate medium.

* * * * *

12. Amend § 2.59 by revising paragraphs (a), (b)(1), and (b)(2) to read as follows:

§ 2.59 Filing substitute specimen(s).

(a) In an application under section 1(a) of the Act, the applicant may submit substitute specimens of the mark as used on or in connection with the goods or in the sale or advertising of the services, or as used to indicate membership in the collective organization. The applicant must submit a verified statement that the substitute specimen was in use in commerce at least as early as the filing date of the application. The verified statement is not required if the specimen is a duplicate or facsimile of a specimen already of record in the application.

(b) * * *

(1) For an amendment to allege use under § 2.76, submit a verified statement that the applicant used the substitute specimen(s) in commerce prior to filing the amendment to allege use.

(2) For a statement of use under § 2.88, submit a verified statement that the applicant used the substitute specimen(s) in commerce either prior to filing the statement of use or prior to the expiration of the deadline for filing the statement of use.

13. Amend § 2.71 as follows:

- a. Revise paragraphs (a) through (b), the introductory text of paragraph (c), and paragraph (d).
- b. Add paragraph (e).

§ 2.71 Amendments to correct informalities.

* * * * *

(a) The applicant may amend the application to clarify or limit, but not to broaden, the identification of goods and/or services or the description of the nature of the collective membership organization.

(b)(1) If the verified statement in an application under § 2.33 is unsigned or signed by the wrong party, the applicant may submit a substitute verification.

(2) If the verified statement in a statement of use under § 2.88, or a request for extension of time to file a statement of use under § 2.89, is unsigned or signed by the wrong party, the applicant must submit a substitute verification before the expiration of the statutory deadline for filing the statement of use.

(c) The applicant may amend the dates of use, provided that the amendment is verified, except that the following amendments are *not* permitted:

* * * * *

(d) The applicant may amend the application to correct the name of the applicant, if there is a mistake in the manner in which the name of the applicant is set out in the application. The amendment must be verified. However, the application cannot be amended to set forth a different entity as the applicant. An application filed in the name of an entity that did not own the mark as of the filing date of the application is void.

(e) An amendment that would materially alter the certification statement specified in § 2.45(a)(4)(i)(A) or § 2.45(a)(4)(ii)(A) will not be permitted.

14. Revise § 2.74(b) to read as follows:

§ 2.74 Form and signature of amendment.

* * * * *

(b) Signature. A request for amendment of an application must be signed by the applicant, someone with legal authority to bind the applicant (e.g., a corporate officer or general partner of a partnership), or a practitioner qualified to practice under § 11.14 of this chapter, in accordance with the requirements of § 2.193(e)(2). If the amendment requires verification, see § 2.2(n).

15. Revise § 2.76 to read as follows:

§ 2.76 Amendment to allege use.

(a) When to file an amendment to allege use. (1) An application under section 1(b) of the Act may be amended to allege use of the mark in commerce under section 1(c) of the Act at any time between the filing of the application and the date the examiner approves the mark for publication. Thereafter, an allegation of use may be submitted only as a statement of use under § 2.88 after the issuance of a notice of allowance under section 13(b)(2) of the Act. An amendment to allege use filed outside the time period specified in this paragraph will not be reviewed.

(2)(i) For a trademark, service mark, collective trademark, collective service mark, and certification mark, an amendment to allege use may be filed only when the mark has been in use in commerce on or in connection with all the goods or services specified in the application, for which the applicant will seek registration. For a collective membership mark, an amendment to allege use may be filed only when the mark has been in use in commerce to indicate membership in the collective organization specified in the application, for which the applicant will seek registration.

(ii) An amendment to allege use may be accompanied by a request in accordance with § 2.87 to divide out from the application the goods, services, or classes not yet in use in commerce.

(b) A complete amendment to allege use. A complete amendment to allege use must include the following:

(1) A verified statement alleging:

(i) The applicant believes the applicant is the owner of the mark;

(ii) The mark is in use in commerce;

(iii) The date of first use of the mark anywhere on or in connection with the goods or services, and/or to indicate membership in the collective organization specified in the application, and the date of first use of the mark in commerce. If the amendment to allege use specifies more than one item of goods or services in a class, the dates of use are required for only one item of goods or services specified in that class;

(iv) The goods, services, and/or nature of the collective membership organization specified in the application; and

(v) For a collective mark and certification mark, the applicant is exercising legitimate control over the use in commerce of the mark.

(2) One specimen showing how the applicant, member, or authorized user uses the mark in commerce. See § 2.56 of this chapter for the requirements for specimens;

(3) The fee per class required by § 2.6;

(4) For a collective mark, the requirements of § 2.44(a)(4)(i)(A);

(5) For a certification mark, the requirements of § 2.45(a)(4)(i)(A)-(C); and

(6) The title “Amendment to Allege Use” should appear at the top of the first page of the document, if not filed through TEAS.

(c) Minimum filing requirements for a timely filed amendment to allege use. The Office will review a timely filed amendment to allege use to determine whether it meets the following minimum requirements:

- (1) The fee required by § 2.6 for at least one class;
- (2) One specimen of the mark as used in commerce; and
- (3) The verified statement in paragraph (b)(1)(ii) of this section.

(d) Deficiency notification. If the amendment to allege use is filed within the permitted time period but does not meet the minimum requirements specified in paragraph (c) of this section, the Office will notify the applicant of the deficiency. The deficiency may be corrected provided the mark has not been approved for publication. If an acceptable amendment to correct the deficiency is not filed prior to approval of the mark for publication, the amendment will not be examined, and the applicant must instead file a statement of use after the notice of allowance issues.

(e) Notification of refusals and requirements. A timely filed amendment to allege use that meets the minimum requirements specified in paragraph (c) of this section will be examined in accordance with § 2.61 through § 2.69. If, as a result of the examination of the amendment to allege use, the applicant is found not entitled to registration for any reason not previously stated, the applicant will be notified and advised of the reasons and of any formal requirements or refusals. The notification shall restate or incorporate by reference all unresolved refusals or requirements previously stated. The amendment to allege use may be amended in accordance with § 2.59 and § 2.71 through § 2.75.

(f) Withdrawal. An amendment to allege use may be withdrawn for any reason prior to approval of a mark for publication.

(g) Verification not filed within reasonable time. If the verified statement in paragraph (b)(1)(ii) of this section is not filed within a reasonable time after it is signed, the Office may require the applicant to submit a substitute verified statement attesting that the mark is still in use in commerce.

(h) An amendment to allege use is not a response but may include amendments. The filing of an amendment to allege use does not constitute a response to any outstanding action by the examiner. See § 2.62. The amendment to allege use may include amendments in accordance with § 2.59 and § 2.71 through § 2.75.

(i) In an application for concurrent use under § 2.42, the amendment to allege use must include a verified statement modified in accordance with § 2.33(f), § 2.44(d), or § 2.45(d).

(j) Multiple-class application. For the requirements of a multiple-class application, see § 2.86.

16. Revise § 2.86 to read as follows:

§ 2.86 Multiple-class applications.

(a) In a single application for a trademark, service mark, and/or collective mark, an applicant may apply to register the same mark for goods, services, and/or a collective membership organization in multiple classes. In a multiple-class application, the applicant must satisfy the following, in addition to the application requirements of § 2.32 for a trademark or service mark, and § 2.44 for collective marks:

(1) For an application filed under section 1 or 44 of the Act, identify the goods or services in each international class and/or the nature of the collective membership organization in U.S.

Class 200; for applications filed under section 66(a) of the Act, identify the goods, services, and/or the nature of the collective membership organization in each international class assigned by the International Bureau in the corresponding international registration;

(2) Submit the application filing fee required by § 2.6 for each class; and

(3) Include either dates of use and one specimen for each class based on section 1(a) of the Act; or a statement that the applicant has a bona fide intention to use the mark in commerce, for a trademark or service mark, or a statement that the applicant has a bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce, for collective marks, for each class based on section 1(b), 44, or 66(a) of the Act. When requested by the Office, additional specimens must be provided.

(b) In a single application for a certification mark, an applicant may apply to register the same mark for goods and services. In such case, the applicant must satisfy the following, in addition to the application requirements of § 2.45:

(1) For an application filed under section 1 or 44 of the Act, identify the goods in U.S. Class A and the services in U.S. Class B; for applications filed under section 66(a) of the Act, identify the goods and services in each international class assigned by the International Bureau in the corresponding international registration;

(2) Submit the application filing fee required by § 2.6 for both classes; and

(3) Include either dates of use and one specimen for each class based on section 1(a) of the Act; or a statement that the applicant has a bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce for each class based on section 1(b), 44, or 66(a) of the Act. When requested by the Office, additional specimens must be provided.

(c) In a single application, both section 1(a) and 1(b) of the Act may not be claimed for identical goods or services.

(d) In a single application, goods or services in U.S. Classes A and/or B may not be combined with either goods or services in any international class or with a collective membership organization in U.S. Class 200. See § 2.45(f).

(e) An amendment to allege use under § 2.76 or a statement of use under § 2.88 for multiple classes must include, for each class, the required fee, dates of use, and one specimen. When requested by the Office, additional specimens must be provided. The applicant may not file an amendment to allege use or a statement of use until the applicant has used the mark on or in connection with all the goods, services, or classes, unless the applicant also files a request to divide under § 2.87.

(f) The Office will issue a single certificate of registration for the mark, unless the applicant files a request to divide under § 2.87.

17. Revise § 2.88 to read as follows:

§ 2.88 Statement of use after notice of allowance.

(a) When to file a statement of use. (1) In an application under section 1(b) of the Act, a statement of use, required under section 1(d) of the Act, must be filed within six months after issuance of a notice of allowance under section 13(b)(2) of the Act, or within an extension of time granted under § 2.89. A statement of use filed prior to issuance of a notice of allowance is premature and will not be reviewed.

(2)(i) For a trademark, service mark, collective trademark, collective service mark, and certification mark, a statement of use may be filed only when the mark has been in use in commerce on or in connection with all the goods or services specified in the notice of allowance,

for which the applicant will seek registration in that application. For a collective membership mark, a statement of use may be filed only when the mark has been in use in commerce to indicate membership in the collective membership organization specified in the notice of allowance, for which the applicant will seek registration in that application.

(ii) A statement of use may be accompanied by a request in accordance with § 2.87 to divide out from the application the goods, services, or classes not yet in use in commerce.

(b) A complete statement of use. A complete statement of use must include the following:

(1) A verified statement alleging:

(i) The applicant believes the applicant is the owner of the mark;

(ii) The mark is in use in commerce;

(iii) The date of first use of the mark anywhere on or in connection with the goods, services, and/or to indicate membership in the collective organization specified in the application, and the date of first use of the mark in commerce. If the statement of use specifies more than one item of goods or services in a class, the dates of use are required for only one item of goods or services specified in that class;

(iv) The goods, services, and/or nature of the collective membership organization specified in the notice of allowance. The goods or services specified in a statement of use must conform to those goods or services specified in the notice of allowance for trademark, service mark, collective trademark, collective service mark, or certification mark applications. Any goods or services specified in the notice of allowance that are omitted from the identification of goods or services in the statement of use will be presumed to be deleted and the deleted goods or services may not be reinserted in the application. For collective membership mark applications,

the description of the nature of the collective membership organization in the statement of use must conform to that specified in the notice of allowance; and

(v) For a collective mark and certification mark, the applicant is exercising legitimate control over the use in commerce of the mark;

(2) One specimen showing how the applicant, member, or authorized user uses the mark in commerce. See § 2.56 for the requirements for specimens;

(3) Fee(s). The fee required by § 2.6 per class. The applicant must pay a filing fee sufficient to cover at least one class within the statutory time for filing the statement of use, or the application will be abandoned. If the applicant submits a fee insufficient to cover all the classes in a multiple-class application, the applicant should specify the classes to be abandoned. If the applicant timely submits a fee sufficient to pay for at least one class, but insufficient to cover all the classes, and the applicant has not specified the class(es) to be abandoned, the Office will issue a notice granting the applicant additional time to submit the fee(s) for the remaining class(es) or to specify the class(es) to be abandoned. If the applicant does not submit the required fee(s) or specify the class(es) to be abandoned within the set time period, the Office will apply the fees paid, beginning with the lowest numbered class(es), in ascending order. The Office will delete the goods or services not covered by the fees submitted;

(4) For a collective mark, the requirements of § 2.44(a)(4)(i)(A);

(5) For a certification mark, the requirements of § 2.45(a)(4)(i)(A)-(C); and

(6) The title “Statement of Use” should appear at the top of the first page of the document, if not filed through TEAS.

(c) Minimum filing requirements for a timely filed statement of use. The Office will review a timely filed statement of use to determine whether it meets the following minimum requirements:

- (1) The fee required by § 2.6 for at least one class;
- (2) One specimen of the mark as used in commerce; and
- (3) The verified statement in paragraph (b)(1) of this section. If this verified statement is unsigned or signed by the wrong party, the applicant must submit a substitute verified statement on or before the statutory deadline for filing the statement of use.

(d) Deficiency notification. If the statement of use is filed within the permitted time period but does not meet the minimum requirements specified in paragraph (c) of this section, the Office will notify the applicant of the deficiency. If the time permitted for the applicant to file a statement of use has not expired, the applicant may correct the deficiency.

(e) Notification of refusals and requirements. A timely filed statement of use that meets the minimum requirements specified in paragraph (c) of this section will be examined in accordance with § 2.61 through § 2.69. If, as a result of the examination of the statement of use, the applicant is found not entitled to registration, the applicant will be notified and advised of the reasons and of any formal requirements or refusals. The statement of use may be amended in accordance with § 2.59 and § 2.71 through § 2.75.

(f) Statement of use may not be withdrawn. The applicant may not withdraw a timely filed statement of use to return to the previous status of awaiting submission of a statement of use, regardless of whether it is in compliance with paragraph (c) of this section.

(g) Verification not filed within reasonable time. If the verified statement in paragraph (b)(1) of this section is not filed within a reasonable time after it is signed, the Office may

require the applicant to submit a substitute verified statement attesting that the mark is still in use in commerce.

(h) Amending the application. The statement of use may include amendments in accordance with § 2.51, § 2.59, and § 2.71 through § 2.75.

(i) In an application for concurrent use under § 2.42, the statement of use must include a verified statement modified in accordance with § 2.33(f), § 2.44(d), or § 2.45(d).

(j) Multiple-class application. For the requirements of a multiple-class application, see § 2.86.

(k) Abandonment. The failure to timely file a statement of use which meets the minimum requirements specified in paragraph (c) of this section shall result in the abandonment of the application.

18. Revise § 2.89 to read as follows:

§ 2.89 Extensions of time for filing a statement of use.

(a) First extension request after issuance of notice of allowance. The applicant may request a six-month extension of time to file the statement of use required by § 2.88. The extension request must be filed within six months of the date of issuance of the notice of allowance under section 13(b)(2) of the Act and must include the following:

- (1) A written request for an extension of time to file the statement of use;
- (2) The fee required by § 2.6 per class. The applicant must pay a filing fee sufficient to cover at least one class within the statutory time for filing the extension request, or the request will be denied. If the applicant submits a fee insufficient to cover all the classes in a multiple-class application, the applicant should specify the classes to be abandoned. If the applicant timely submits a fee sufficient to pay for at least one class, but insufficient to cover all the

classes, and the applicant has not specified the class(es) to be abandoned, the Office will issue a notice granting the applicant additional time to submit the fee(s) for the remaining classes, or specify the class(es) to be abandoned. If the applicant does not submit the required fee(s) or specify the class(es) to be abandoned within the set time period, the Office will apply the fees paid, beginning with the lowest numbered class(es), in ascending order. The Office will delete the goods or services not covered by the fees submitted; and

(3) A verified statement that the applicant continues to have a bona fide intention to use the mark in commerce, for trademarks or service marks, or that the applicant continues to have a bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce, for collective marks or certification marks. If this verified statement is unsigned or signed by the wrong party, the applicant must submit a substitute verified statement within six months of the date of issuance of the notice of allowance.

(b) Subsequent extension requests. Before the expiration of the previously granted extension of time, the applicant may request further six-month extensions of time to file the statement of use by submitting the following:

(1) A written request for an extension of time to file the statement of use;

(2) The requirements of paragraph (a)(2) of this section for a fee;

(3) A verified statement that the applicant continues to have a bona fide intention to use the mark in commerce, for trademarks or service marks, or that the applicant continues to have a bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce, for collective marks or certification marks. If this verified statement is unsigned or signed by the wrong party, the applicant must submit a substitute verified statement before the expiration of the previously granted extension; and

(4) A showing of good cause, as specified in paragraph (d) of this section.

(c) Four subsequent extension requests permitted. Extension requests specified in paragraph (b) of this section will be granted only in six-month increments and may not aggregate more than 24 months total.

(d) Good cause. A showing of good cause must include:

(1) For a trademark or service mark, a statement of the applicant's ongoing efforts to make use of the mark in commerce on or in connection with each of the relevant goods or services. Those efforts may include product or service research or development, market research, manufacturing activities, promotional activities, steps to acquire distributors, steps to obtain governmental approval, or other similar activities. In the alternative, the applicant must submit a satisfactory explanation for the failure to make efforts to use the mark in commerce.

(2) For a collective mark, a statement of ongoing efforts to make use of the mark in commerce by members on or in connection with each of the relevant goods or services or in connection with the applicant's collective membership organization. Those efforts may include the development of standards, the steps taken to acquire members such as marketing and promotional activities targeted to potential members, training members regarding the standards, or other similar activities. In the alternative, the applicant must submit a satisfactory explanation for the failure to make efforts for applicant's members to use the mark in commerce.

(3) For a certification mark, a statement of ongoing efforts to make use of the mark in commerce by authorized users on or in connection with each of the relevant goods or services. Those efforts may include the development of certification standards, steps taken to obtain governmental approval or acquire authorized users, marketing and promoting the recognition of the certification program or of the goods or services that meet the certification standards of the

applicant, training authorized users regarding the standards, or other similar activities. In the alternative, the applicant must submit a satisfactory explanation for the failure to make efforts for applicant's authorized users to use the mark in commerce.

(e) Extension request filed in conjunction with or after a statement of use. (1) An applicant may file one request for a six-month extension of time for filing a statement of use when filing a statement of use or after filing a statement of use if time remains in the existing six-month period in which the statement of use was filed, provided that the time requested would not extend beyond 36 months from the date of issuance of the notice of allowance. Thereafter, applicant may not request any further extensions of time.

(2) A request for an extension of time that is filed under paragraph (e)(1) of this section, must comply with all the requirements of paragraph (a) of this section, if it is an applicant's first extension request, or paragraph (b) of this section, if it is a second or subsequent extension request. However, in a request under paragraph (b) of this section, an applicant may satisfy the requirement for a showing of good cause by asserting the applicant believes the applicant has made valid use of the mark in commerce, as evidenced by the submitted statement of use, but that if the statement of use is found by the Office to be fatally defective, the applicant will need additional time in which to file a new statement of use.

(f) Goods or services. For trademark, service mark, collective trademark, collective service mark, or certification mark applications, the goods or services specified in a request for an extension of time for filing a statement of use must conform to those goods or services specified in the notice of allowance. Any goods or services specified in the notice of allowance that are omitted from the identification of goods or services in the request for extension of time will be presumed to be deleted and the deleted goods or services may not thereafter be reinserted

in the application. For collective membership mark applications, the description of the nature of the collective membership organization in the request for extension of time must conform to that set forth in the notice of allowance.

(g) Notice of grant or denial. The applicant will be notified of the grant or denial of a request for an extension of time, and of the reasons for a denial. Failure to notify the applicant of the grant or denial of the request prior to the expiration of the existing period or requested extension does not relieve the applicant of the responsibility of timely filing a statement of use under § 2.88. If, after denial of an extension request, there is time remaining in the existing six-month period for filing a statement of use, applicant may submit a substitute request for extension of time to correct the defects of the prior request. Otherwise, the only recourse available after denial of a request for an extension of time is to file a petition to the Director in accordance with § 2.66 or § 2.146. A petition from the denial of an extension request must be filed within two months of the date of issuance of the denial of the request. If the petition is granted, the term of the requested six-month extension that was the subject of the petition will run from the date of expiration of the previously existing six-month period for filing a statement of use.

(h) Verification not filed within reasonable time. If the verified statement is not filed within a reasonable time after it is signed, the Office may require the applicant to submit a substitute verified statement attesting that the applicant continues to have a bona fide intention to use the mark in commerce, or the applicant continues to have a bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce.

19. Amend § 2.146 by revising paragraphs (c) and (d) to read as follows:

§ 2.146 Petitions to the Director.

* * * * *

(c) Every petition to the Director shall include a statement of the facts relevant to the petition, the points to be reviewed, the action or relief requested, and the fee required by § 2.6. Any brief in support of the petition shall be embodied in or accompany the petition. The petition must be signed by the petitioner, someone with legal authority to bind the petitioner (e.g., a corporate officer or general partner of a partnership), or a practitioner qualified to practice under § 11.14 of this chapter, in accordance with the requirements of § 2.193(e)(5). When facts are to be proved on petition, the petitioner must submit proof in the form of verified statements signed by someone with firsthand knowledge of the facts to be proved, and any exhibits.

(d) A petition must be filed within two months of the date of issuance of the action from which relief is requested, unless a different deadline is specified elsewhere in this chapter, and no later than two months from the date when Office records are updated to show that the registration has been cancelled or has expired.

* * * * *

20. Amend § 2.161 as follows:

- a. Revise paragraphs (b), (c), (d)(1), (d)(3), and (e) through (g).
- b. Add paragraphs (i) through (k).

§ 2.161 Requirements for a complete affidavit or declaration of continued use or excusable nonuse.

* * * * *

(b) Include a verified statement attesting to the use in commerce or excusable nonuse of the mark within the period set forth in section 8 of the Act. This verified statement must be executed on or after the beginning of the filing period specified in § 2.160(a);

(c) Include the U.S. registration number;

(d)(1) Include the fee required by § 2.6 for each class that the affidavit or declaration covers;

* * * * *

(3) If at least one fee is submitted for a multiple-class registration, but the fee is insufficient to cover all the classes, and the class(es) to which the fee(s) should be applied are not specified, the Office will issue a notice requiring either submission of the additional fee(s) or specification of the class(es) to which the initial fee(s) should be applied. Additional fee(s) may be submitted if the requirements of § 2.164 are met. If the additional fee(s) are not submitted within the time period set out in the Office action and the class(es) to which the original fee(s) should be applied are not specified, the Office will presume that the fee(s) cover the classes in ascending order, beginning with the lowest numbered class;

(e)(1) Specify the goods, services, or nature of the collective membership organization for which the mark is in use in commerce, and/or the goods, services, or nature of the collective membership organization for which excusable nonuse is claimed under paragraph (f)(2) of this section; and

(2) Specify the goods, services, or classes being deleted from the registration, if the affidavit or declaration covers fewer than all the goods, services, or classes in the registration;

(f)(1) State that the registered mark is in use in commerce; or

(2) If the registered mark is not in use in commerce on or in connection with all the goods, services, or classes specified in the registration, set forth the date when such use of the mark in commerce stopped and the approximate date when such use is expected to resume; and recite facts to show that nonuse as to those goods, services, or classes is due to special circumstances that excuse the nonuse and is not due to an intention to abandon the mark; and

(g) Include one specimen showing how the mark is in use in commerce for each class in the registration, unless excusable nonuse is claimed under paragraph (f)(2) of this section. When requested by the Office, additional specimens must be provided. The specimen must meet the requirements of § 2.56 of this chapter.

* * * * *

(i) Additional requirements for a collective mark. In addition to the above requirements, a complete affidavit or declaration pertaining to a collective mark must:

(1) State that the owner is exercising legitimate control over the use of the mark in commerce; and

(2) State the nature of the owner's control over the use of the mark by the members in the first affidavit or declaration filed under paragraph (a) of this section for registrations which issued from an application based solely on section 44 of the Act.

(j) Additional requirements for a certification mark. In addition to the above requirements, a complete affidavit or declaration pertaining to a certification mark must:

(1) Include a copy of the certification standards specified in § 2.45(a)(4)(i)(B);

(i) Submitting certification standards for the first time. If the registration issued from an application based solely on section 44 of the Act, include a copy of the certification standards in the first affidavit or declaration filed under paragraph (a) of this section; or

(ii) Certification standards submitted in prior filing. If the certification standards in use at the time of filing the affidavit or declaration have not changed since the date they were previously submitted to the Office, include a statement to that effect; if the certification standards in use at the time of filing the affidavit or declaration have changed since the date they were previously submitted to the Office, include a copy of the revised certification standards;

(2) State that the owner is exercising legitimate control over the use of the mark in commerce; and

(3) Satisfy the requirements of § 2.45(a)(4)(i)(A), (C).

(k) For requirements of a complete affidavit or declaration of use in commerce or excusable nonuse for a registration that issued from a section 66(a) basis application, see § 7.37.

21. Amend § 2.167 as follows:

- a. Revise the introductory text and paragraphs (a), and (c) through (g).
- b. Add paragraphs (h) through (k).

§ 2.167 Affidavit or declaration under section 15.

The affidavit or declaration in accordance with § 2.20 provided by section 15 of the Act for acquiring incontestability for a mark registered on the Principal Register or a mark registered under the Trademark Act of 1881 or 1905 and published under section 12(c) of the Act (see § 2.153 of this chapter) must:

(a) Be verified;

* * * * *

(c) For a trademark, service mark, collective trademark, collective service mark, and certification mark, recite the goods or services stated in the registration on or in connection with which the mark has been in continuous use in commerce for a period of five years after the date of registration or date of publication under section 12(c) of the Act, and is still in use in commerce; for a collective membership mark, describe the nature of the owner's collective membership organization specified in the registration in connection with which the mark has been in continuous use in commerce for a period of five years after the date of registration or date of publication under section 12(c) of the Act, and is still in use in commerce;

(d) Specify that there has been no final decision adverse to the owner's claim of ownership of such mark for such goods, services, or collective membership organization, or to the owner's right to register the same or to keep the same on the register;

(e) Specify that there is no proceeding involving said rights pending in the Office or in a court and not finally disposed of;

(f) Be filed within one year after the expiration of any five-year period of continuous use following registration or publication under section 12(c) of the Act; and

(g) Include the fee required by § 2.6 for each class to which the affidavit or declaration pertains in the registration. If no fee, or a fee insufficient to cover at least one class, is filed at an appropriate time, the affidavit or declaration will not be refused if the required fee(s) (see § 2.6) is filed in the Office within the time limit set forth in the notification of this defect by the Office. If the submitted fees are insufficient to cover all classes in the registration, the particular class or classes to which the affidavit or declaration pertains should be specified.

(h) If the affidavit or declaration fails to satisfy any of the requirements in paragraphs (a) through (g) of this section, the owner will be notified in an Office action that the affidavit or declaration cannot be acknowledged. If a response is not received within the time period provided or does not satisfy the requirements of the Office action, the affidavit or declaration will be abandoned.

(i) If the affidavit or declaration satisfies paragraphs (a) through (g) of this section, the Office will issue a notice of acknowledgement.

(j) An affidavit or declaration may be abandoned by the owner upon petition to the Director under § 2.146 either before or after the notice of acknowledgement has issued.

(k) If an affidavit or declaration is abandoned, the owner may file a new affidavit or declaration with a new filing fee.

22. Amend § 2.173 as follows:

a. Revise paragraphs (b), and (d) through (g).

b. Add paragraphs (h) and (i).

§ 2.173 Amendment of registration.

* * * * *

(b) Requirements for request. A request for amendment or disclaimer must:

(1) Include the fee required by § 2.6;

(2) Be verified and signed in accordance with § 2.193(e)(6); and

(3) If the amendment involves a change in the mark: a specimen showing the mark as used on or in connection with the goods, services, or collective membership organization; a verified statement that the specimen was in use in commerce at least as early as the filing date of the amendment; and a new drawing of the amended mark. When requested by the Office, additional specimens must be provided.

(4) The Office may require the owner to furnish such specimens, information, exhibits, and affidavits or declarations as may be reasonably necessary to the proper examination of the amendment.

(c) Registration must still contain registrable matter. The registration as amended must still contain registrable matter, and the mark as amended must be registrable as a whole.

(d) Amendment may not materially alter the mark. An amendment or disclaimer that materially alters the character of the mark will not be permitted, in accordance with section 7(e) of the Act.

(e) Amendment of identification of goods, services, or collective membership organization.

No amendment in the identification of goods or services, or description of the nature of the collective membership organization, in a registration will be permitted except to restrict the identification or to change it in ways that would not require republication of the mark.

(f) Amendment of certification statement for certification marks. An amendment of the certification statement specified in § 2.45(a)(4)(i)(A) or (a)(4)(ii)(A) that would materially alter the certification statement will not be permitted, in accordance with section 7(e) of the Act.

(g) Conforming amendments may be required. If the registration includes a disclaimer, description of the mark, or other miscellaneous statement, any request to amend the registration must include a request to make any necessary conforming amendments to the disclaimer, description, or other statement.

(h) Elimination of disclaimer. No amendment seeking the elimination of a disclaimer will be permitted, unless deletion of the disclaimed portion of the mark is also sought.

(i) No amendment to add or delete section 2(f) claim of acquired distinctiveness. An amendment seeking the addition or elimination of a claim of acquired distinctiveness will not be permitted.

23. Revise § 2.175(b)(2) as follows:

§ 2.175 Correction of mistake by owner.

* * * * *

(b) * * *

(2) Be verified; and

* * * * *

24. Amend § 2.183 by revising paragraphs (d) and (e) to read as follows:

§ 2.183 Requirements for a complete renewal application.

* * * * *

(d) If the renewal application covers less than all the goods, services, or classes in the registration, then a list specifying the particular goods, services, or classes to be renewed.

(e) If at least one fee is submitted for a multiple-class registration, but the fee is insufficient to cover all the classes and the class(es) to which the fee(s) should be applied are not specified, the Office will issue a notice requiring either the submission of additional fee(s) or an indication of the class(es) to which the original fee(s) should be applied. Additional fee(s) may be submitted if the requirements of § 2.185 are met. If the required fee(s) are not submitted and the class(es) to which the original fee(s) should be applied are not specified, the Office will presume that the fee(s) cover the classes in ascending order, beginning with the lowest numbered class.

* * * * *

25. Amend § 2.193 by revising paragraphs (c)(2), (e) introductory text, (e)(1), and (f) to read as follows:

§ 2.193 Trademark correspondence and signature requirements.

* * * * *

(c) * * *

(2) Sign the document using some other form of electronic signature specified by the Director.

* * * * *

(e) Proper person to sign. Documents filed in connection with a trademark application or registration must be signed by a proper person. Unless otherwise specified by law, the following requirements apply:

(1) Verified statement of facts. A verified statement in support of an application for registration, amendment to an application for registration, allegation of use under § 2.76 or § 2.88, request for extension of time to file a statement of use under § 2.89, or an affidavit under section 8, 12(c), 15, or 71 of the Act must satisfy the requirements of § 2.2(n), and be signed by the owner or a person properly authorized to sign on behalf of the owner. A person who is properly authorized to verify facts on behalf of an owner is:

* * * * *

(f) Signature as certification. The presentation to the Office (whether by signing, filing, submitting, or later advocating) of any document by any person, whether a practitioner or non-practitioner, constitutes a certification under § 11.18(b) of this chapter. Violations of § 11.18(b) of this chapter may jeopardize the validity of the application or registration, and may result in the imposition of sanctions under § 11.18(c) of this chapter. Any practitioner violating § 11.18(b) of this chapter may also be subject to disciplinary action. See § 11.18(d) and § 11.804 of this chapter.

* * * * *

PART 7—RULES OF PRACTICE IN FILINGS PURSUANT TO THE PROTOCOL RELATING TO THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS

26. The authority citation for 37 CFR Part 7 continues to read as follows:

Authority: 15 U.S.C. 1123, 35 U.S.C. 2, unless otherwise noted.

27. Amend § 7.1 as follows:

- a. Revise paragraph (c).
- b. Add paragraph (f).

§ 7.1 Definitions of terms as used in this part.

* * * * *

(c) The acronym TEAS means the Trademark Electronic Application System, available at <http://www.uspto.gov>.

* * * * *

(f) The definitions specified in § 2.2(k) and (n) of this chapter are incorporated in this part.

28. Amend § 7.37 as follows:

- a. Revise paragraphs (b) introductory text, (b)(1), (d)(1), (d)(3), (e), (f)(1), and (g).
- b. Add paragraphs (i) and (j).

§ 7.37 Requirements for a complete affidavit or declaration of use in commerce or excusable nonuse.

* * * * *

(b) Include a verified statement attesting to the use in commerce or excusable nonuse of the mark within the period set forth in section 71 of the Act. The verified statement must be executed on or after the beginning of the filing period specified in § 7.36(b). A person who is properly authorized to sign on behalf of the holder is:

- (1) A person with legal authority to bind the holder;

* * * * *

(d)(1) Include the fee required by § 7.6 for each class that the affidavit or declaration covers;

* * * * *

(3) If at least one fee is submitted for a multiple-class registration, but the fee is insufficient to cover all the classes and the class(es) to which the fee(s) should be applied are not specified, the Office will issue a notice requiring either submission of the additional fee(s) or specification of the class(es) to which the initial fee(s) should be applied. Additional fees may be submitted if the requirements of § 7.39 are met. If the additional fee(s) are not submitted within the time period set out in the Office action and the class(es) to which the original fee(s) should be applied are not specified, the Office will presume that the fee(s) cover the classes in ascending order, beginning with the lowest numbered class;

(e)(1) Specify the goods, services, or nature of the collective membership organization for which the mark is in use in commerce, and/or the goods, services, or nature of the collective membership organization for which excusable nonuse is claimed under paragraph (f)(2) of this section;

(2) Specify the goods, services, or classes being deleted from the registration, if the affidavit or declaration covers fewer than all the goods, services, or classes in the registration;

(f)(1) State that the registered mark is in use in commerce; or

(2) If the registered mark is not in use in commerce on or in connection with all the goods, services, or classes specified in the registration, set forth the date when such use of the mark in commerce stopped and the approximate date when such use is expected to resume and recite facts to show that nonuse as to those goods, services, or classes is due to special circumstances that excuse the nonuse and is not due to an intention to abandon the mark;

(g) Include one specimen showing how the mark is used in commerce for each class in the registration, unless excusable nonuse is claimed under paragraph (f)(2) of this section. When requested by the Office, additional specimens must be provided. The specimen must meet the requirements of § 2.56 of this chapter.

* * * * *

(i) Additional requirements for a collective mark. In addition to the above requirements, a complete affidavit or declaration pertaining to a collective mark must:

(1) State that the owner is exercising legitimate control over the use of the mark in commerce; and

(2) State the nature of the owner's control over the use of the mark by the members in the first affidavit or declaration filed under paragraph (a) of this section.

(j) Additional requirements for a certification mark. In addition to the above requirements, a complete affidavit or declaration pertaining to a certification mark must:

(1) Include a copy of the certification standards specified in § 2.45(a)(4)(i)(B) of this chapter;

(i) Submitting certification standards for the first time. In the first affidavit or declaration filed under paragraph (a) of this section, include a copy of the certification standards; or

(ii) Certification standards submitted in prior filing. If the certification standards in use at the time of filing the affidavit or declaration have not changed since the date they were previously submitted to the Office, include a statement to that effect; if the certification standards in use at the time of filing the affidavit or declaration have changed since the date they were previously submitted to the Office, include a copy of the revised certification standards;

(2) State that the owner is exercising legitimate control over the use of the mark in commerce; and

(3) Satisfy the requirements of § 2.45(a)(4)(i)(A) and (C) of this chapter.

Date: February 10, 2014.

Michelle K. Lee,
Deputy Under Secretary of Commerce for
Intellectual Property and Deputy Director,
United States Patent and Trademark Office.

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